

Application No. 10/675,820
Amendment dated May 7, 2008
Reply to Office Action of February 7, 2008

(See KSR v. Teleflex, 127 S.Ct. 1727 (2007)). Under Graham v. John Deere, the question of obviousness is resolved on the basis of factual determinations including (1) the scope and content of the prior art, (2) the differences between the claimed invention and the prior art, (3) the level of ordinary skill in the pertinent art, and (4) where in evidence, so-called secondary considerations. (See Graham v. John Deere, at 17-18, 148 U.S.P.Q. at 467.) However, even under Graham v. John Deere, prior art that is non-analogous to the claimed invention and/or references that teach away from a combination thereof support a finding of nonobviousness. In response to the Examiner's rejection of independent claim 1, Applicant submits that Thompson is non-analogous art to the claimed invention and that Cauthen and Thomspen teach away from one another.

Thompson is directed to video gynecological examination apparatus used in conjunction with conventional speculums for dilating a patient's vagina. The Examiner relies on one of the conventional speculums disclosed in Thompson in rejecting independent claim 1. According to the Examiner, Thompson discloses the feature of "having two curved halves articulate about an axis that passes through at least a portion of the passageway (see joints via 123)." As shown in Fig. 3 of Thompson, the element labeled with the number 123 properly refers to arms formed on either side of a speculum 103. The arms 123 space apart an upper portion and a lower portion of the speculum 103, and are hingedly connected to the upper portion. The arms 123 and associated hinged connections are positioned at the trailing end of the speculum 103, and the leading end of the speculum 103 (including most of the upper and lower portions) are inserted into the patient's vagina.

According to MPEP § 2141.01, "a reference in a field different from that of applicant's endeavor may be reasonably pertinent if it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his or her invention as a whole." Hence, the pertinence of a reference is determined by if the reference can be logically associated with the claimed invention.

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Applicant submits that the speculum 103 of Thompson is not logically associated with the claimed invention. The speculum 103 is inserted into a patient's vagina to facilitate dilation thereof, and is not even remotely related to a guard for use in human spinal surgery as claimed in independent claim 1. As such, Thompson is non-analogous art to the claimed invention. Accordingly, Applicant submits that Thomson cannot be used as the basis for an obviousness rejection of independent claim 1.

Furthermore, Applicant submits that Cauthen and Thompson teach away from one another. Cauthen teaches two instruments (10), one of Figs. 1 and 2 and another of Figs. 13 and 14. The insertion instrument (10) of Figs. 1 and 2 includes a hollow body (12), and a handle (18) with a guide (20) extending therefrom pivotal about an articulating hinge (22). The articulating hinge (22) has a pivot axis disposed on the exterior of the hollow body (12), and is positioned adjacent the leading end of the insertion instrument (10) of Figs. 1 and 2. The insertion instrument (10) of Figs. 13 and 14 includes a hollow body (12), and a handle (18) with an associated guide (20) and a handle (37) with an associated guide (35) pivotal about articulating hinges (22) and (36), respectively. The articulating hinges (22) and (36) have pivot axes disposed on the exterior of the hollow body, and positioned adjacent the leading end of the insertion instrument (10) of Figs. 13 and 14.

Accordingly, contrary to the teachings of Thompson, Cauthen teaches that the articulating hinge (22) of Figs. 1 and 2 and the articulating hinges (22) and (36) of Figs. 13 and 14 are positioned adjacent the leading ends of the insertion instruments (10). Furthermore, while the pivot axes of the articulating hinge (22) of Figs. 1 and 2 and the articulating hinges (22) and (36) of Figs. 13 and 14 are disposed on the exterior of the hollow bodies (12), the handle (18) and the handles (18) and (37) of Cauthen, contrary to the teachings of Thompson, are not offset from the hollow bodies (12). As such, besides being non-analogous art, Applicant submits Cauthen and Thompson teach away from one another. Therefore, Applicant submits that the Examiner's rejection under 35 U.S.C. § 103(a) based on Cauthen and Thompson cannot be maintained.

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Also, the Examiner rejected dependent claim 29 under 35 U.S.C. § 103(a) as being unpatentable over Cauthen and Thompson in further view of U.S. Publication No. 2003/0023209; and rejected dependent claim 30 under 35 U.S.C. § 103(a) as being unpatentable over Cauthen and Thompson in further view of U.S. Publication No. 2003/0229401. In response, Applicant submits that, given the patentability of independent claim 1, the Examiner's rejections of dependent claims 29 and 30 are now moot.

In conclusion, Applicant submits that independent claim 1 is patentable and that dependent claims 2-30 dependent from independent claim 1, or claims dependent therefrom, are patentable at least due to their dependency from an allowable independent claim. Therefore, in view of the foregoing remarks, it is respectfully submitted that the claims are patentable. It is requested that the Examiner reconsider the outstanding rejections in view of the preceding comments. Issuance of a timely Notice of Allowance of the claims is earnestly solicited.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this reply, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 50-3726.

Respectfully submitted,

MARTIN & FERRARO, LLP

Dated: May 7, 2008

By: 
Thomas H. Martin
Registration No. 34,383

1557 Lake O'Pines Street, NE
Hartville, Ohio 44632
Telephone: (330) 877-0700
Facsimile: (330) 877-2030